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OFFICE OF PETITIONS

ON PETITION

In re Gluck
Patent No. 6,142,532
Application No. 09/149,747
Filed: September 8, 1998
Issued: November 7, 2000
Attorney Docket No. 237/037

This is a decision on the petition under 37 CFR § 1.181(a)(3), filed September 9, 2002, invoking the supervisory authority of the Commissioner to review the refusal of the Certificate of Correction Branch to issue a Certificate of Correction. The petition has been filed in the alternative under under 37 CFR 1.182 and 37 CFR 1.183, and such petitions request nullification of the current terminal disclaimer to the extent it applies to patent no. 5,417,431, rather than patent no. 5,803,501.

The petition under 37 CFR 1.181 is **dismissed**.

The petition under 37 CFR 1.182 is **dismissed**.

The petition under 37 CFR 1.183 is **dismissed**.

Background

On November 25, 1998, the examiner rejected claims under the judicially created doctrine of double patenting based on patent no. 5,803,501.

Subsequently, a terminal disclaimer was filed in response to the rejection. The terminal disclaimer inadvertently listed patent no. 5,417,431 rather than patent no. 5,803,501.

On November 7, 2000, the patent issued.

On June 10, 2002, petitioner requested a certificate of correction

The request was denied by the Decisions and Certificate of Correction Branch on July 25, 2002.

On September 9, 2002, the instant petition was filed.

Statute

35 U.S.C. 254 states,

> "Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner **may** issue a certificate of correction." (Emphasis added)

35 U.S.C. 255 states,

> Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director **may**, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. (Emphasis added)

Opinion

The standard of review of the decision of July 25, 2002 (Decision) is whether the decision was arbitrary and capricious, such that the decision is tantamount to an abuse of discretion. The requested review, however, fails to reveal any error in the decision in regard to the issuance of a certificate of correction under 35 USC 254 or 35 USC 255.

A Certificate of Correction may not enlarge the scope of the claims.[1] Petitioner requests a change which will alter the term of the patent. If petitioner's request was granted, the patent's "claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged."[2] Since the requested Certificate of Correction would enlarge the scope of the claims, the petition cannot be granted.

As for the petition under 37 CFR 1.182, the mechanisms provided by Congress to correct a patent are certificate of correction, reissue, and reexamination. The Office will not unilaterally create new mechanisms to correct "mistakes" subsequent to the issuance of an application as a patent. A standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing). Absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation.[3] Since Congress has provided a specific scheme for the correction of patents, the creation of other schemes (*e.g.*, 37 CFR 1.182 or 1.183) for the correction of patents would be inconsistent with the patent statutes. Thus, the Commissioner's authority to correct patents is limited to that specified in the statutory scheme set forth by Congress.

As for the petition under 37 CFR 1.183, the Office may waive the requirements of a rule, but the Office lacks the authority of discretion to relax any requirement imposed by statute.[4] The Office may not circumvent the statutory schemes created by Congress to correct patents.

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[1] In re Arnott, 19 USPQ2d 1049 (Comm'r Pat. 1991) ("Where a proposed correction involves a change in claim scope, the reissue statute is controlling, not the provisions of law governing Certificates of Correction.") *citing*, Eagle Iron Works v. McLanahan Corporation, 429 F.2d 1375, 1383, 166 USPQ 225, 231 (3d Cir. 1970).)

[2] Ex Parte Anthony, 230 USPQ 467 (Bd. App. 1982), *aff'd*, No. 84-1357 (Fed. Cir. June 14, 1985).

[3] See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode").

[4] See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot by rule or waiver of the rules fashion remedies that contravene 35 USC sections 112 and 120), A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir. 1977) (As an executive agency, PTO must follow strict provisions of statute).

A discussion of the role of reissue and reexamination applications to withdraw or nullify a terminal disclaimer can be found at MPEP 1490(B).

The instant petition should not be interpreted to preclude petitioner from submitting a terminal disclaimer for patent no. 5,803,501 in addition to (not to replace) the terminal disclaimer currently in force. Petitioner *may* file a petition under 37 CFR 1.182 to enter the additional disclaimer if, out of an abundance of caution, petitioner wishes to have the additional terminal disclaimer entered into the file. The submission of the additional disclaimer would not need to be accompanied by a request for a Certificate of Correction since the terminal disclaimer would simply be entered into the file which is open to public inspection.

At this time, the petition fees for the petitions under 37 CFR 1.182 and 1.183 will be charged to petitioner's deposit account.

Decision

The prior decision regarding issuance of a certificate of correction for the above-identified patent has been reconsidered. For the reasons herein and stated in the previous decision, a certificate of correction can not be issued under 35 USC 254 or 255. For the reasons stated in this decision, the petitions under 37 CFR 1.182 and 1.183 are dismissed.

The file is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

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